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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT EXAMINING OPERATIONS

Applicant: Seiji Yamashita Group Art Unit: 1741
Serial No.: 09/507,212 Examiner: Tran, T
Filed: February 18, 2000 Docket No.: P 00 572.006

Title: METHOD AND APPARATUS FOR REDUCING
CONTAMINATION IN A PLASTIC CONTAINER

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being transmitted by facsimile to: No. 1-703-872-9311, Commissioner for Patents, Washington, DC 20231 on March 6, 2003.
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March 6, 2003

OFFICIAL
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REQUEST FOR RECONSIDERATION

Box: AF - Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Greetings:

This Request for Reconsideration is being filed in response to the Office Action of January 10, 2003.

Claims 10-13 and 23 remained rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,235,358 to Goto.

Page 1 - REQUEST FOR RECONSIDERATION (09/507,212)

Consisting essentially of

According to MPEP 2111.03, the "transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials and steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention. *In re Hertz*, 537 F.2d 549, 551-552 190 USPQ 461, 463 (CCPA 1976)."

In claim 10, Applicant recites "the coating **consisting essentially of** titanium dioxide so as to attract water molecules to produce a hydrophilic surface on the container for facilitating cleaning the container." According to MPEP 2111.03 mentioned above, items that "materially affect the basic and novel characteristic(s)" of the claimed invention do not fall within the scope of the claim. MPEP 2111.03 also states that "[i]f an applicant contends that additional steps or materials are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re Lajarte*, 337 F.2d 870, 872, 143 USPQ 256 (CCPA 1964)."

As evidenced by the Declaration of Professor Philip R. Watson, Professor of Chemistry at Oregon State University, the coating in Goto includes the added ingredient of epoxy resin, which materially affects the basic and novel characteristics of the claimed invention. Professor Watson stated in his Declaration that "the coating disclosed in Goto would not provide titanium dioxide molecules in a form that makes them available to form a hydrophilic surface on a container to facilitate cleaning the container."

In *In re Lajarte* the applicant claimed an "electrically insulating glass having a composition consisting essentially of," and listed the ingredients used to form the glass. The

Examiner rejected the claim citing U.S. Patent No. 2,443,142 to Lyle, which contained the claimed ingredients plus the additional ingredients of sulfur and carbon. The board had argued the following:

Lyle discloses that a very small amount of carbon, less than $\frac{1}{2}$ of 1%, is employed in the preparation of his glass composition A. In our opinion it would not be expected that the presence of this small amount of carbon would substantially alter the electrical resistance of the glass composition. Claim 11 which recites 'consisting essentially' the named ingredients does not exclude small amounts of other materials which do not change the essential character of the composition. In our opinion, it must also be considered that some of the charcoal employed by Lyle may be lost due to atmospheric oxidation during the preparation of the final glass. In the absence of a factual showing of a critical difference in the electrical resistance of applicant's glass composition compared to that of the compositions taught by Lyle, we are of the view that claim 11 does not patentably distinguish from the reference. (Emphasis added.)

In re Lajarte, 337 F.2d 870, 872, 143 USPQ 256, 258 (CCPA 1964).

However, in response to this argument, the Court of Custom and Patent Appeals disagreed with the board and stated:

In the total absence of evidence in the record to indicate that the amber glass disclosed by Lyle would be expected to have desirable electrical insulating properties, we can find no justification for placing the burden on applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle. Although there are only very slight differences between the Lyle composition and that sought to be patented, we cannot assume that these small differences are incapable of causing a difference in properties. Applicant in showing that his glass has basic and novel properties (at least as far as the record is concerned), would appear to have met his burden.

In re Lajarte, 337 F.2d 870, 872, 143 USPQ 256, 259 (CCPA 1964).

In compliance with MPEP 2111.03, Applicant has met the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention by providing evidence that "the coating disclosed in Goto would not

provide titanium dioxide molecules in a form that makes them available to form a hydrophilic surface on a container to facilitate cleaning the container." However, the Office Action does not give this evidence sufficient weight.

The Office Action stated that:

[i]n the Declaration, received on October 30, 2002, Applicant provides various opinions to state that Goto's coating layer is different from the presently claimed invention. However, merely stating one's opinions cannot be scientifically founded to show the novelty of the present invention over the prior art. It is recommended that Applicant provide concrete scientific evidence, such as experimental data including comparative examples, to show different results that are patentably distinguishable from the prior art.

However, this requirement contradicts the Court of Custom and Patent Appeals, which stated in *In re Lajarte*, 337 F.2d 870, 143 USPQ 256, 258 (CCPA 1964) that "we can find no justification for placing the burden on applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle." That is there is no justification for placing the burden on applicant to conduct experiments to determine the hydrophilic properties of the Goto reference.

Moreover, from the above statement in the Office Action, it appears that there is confusion between an opinion statement and a factual statement. Professor Watson's statement that "the coating disclosed in Goto would not provide titanium dioxide molecules in a form that makes them available to form a hydrophilic surface on a container to facilitate cleaning the container" is a factual statement.

This is similar to *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996) in which a declaration was provided by an expert that commented on the characteristics of a chemical composition in regard

to a 35 U.S.C. §112(1) rejection. The Federal Circuit stated:

...the examiner interpreted the Wall declaration as offering opinion evidence, rather than factual evidence The Wall declaration's assertion that "[m]odifying the residue at position 81 would have no effect on [disulfide bridge formation] because neither [asparagine] nor lysine can participate in disulfide bridge formation" is a factual statement. . . . Dr. Wall's use of the words "it is my opinion" does not transform the factual statements contained in the declaration into opinion testimony. (Emphasis added)

In re Alton, 76 F.3d at 1174-75.

Professor Watson's statements regarding the Goto reference are factual statements that must be given weight. MPEP 716.01

Applicant has surpassed his burden by providing factual evidence from a Professor of Chemistry at Oregon State University that "the coating disclosed in Goto would not provide titanium dioxide molecules in a form that makes them available to form a hydrophilic surface on a container to facilitate cleaning the container. There is no evidence of record to the contrary. The foregoing is sufficient to overcome the rejection based in the Goto reference.

Response to further arguments in the Office Action

In regard to the argument in the Office Action that "Goto's coating layer would also inherently attract atmospheric water as presently claimed," Applicant has provided factual evidence that this statement is incorrect. (See the Declaration)

The Office Action also stated that "it has been well settled that limitations on the properties of materials worked upon or functional limitations have been held to have insignificant patentable weight in an apparatus claim. See MPEP 2114-2115."

Page 5 - REQUEST FOR RECONSIDERATION (09/507,212)

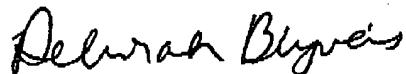
MPEP 2114 states that "apparatus claims must be structurally distinguishable from the prior art." However, as explained by the Federal Circuit, functional language can provide this structural distinction. For example, in *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1362 (Fed.Cir. 1999), the Federal Circuit stated in regard to claim language, "[t]he functional language is, of course, an additional limitation in the claim."

MPEP 2115 states "material or article worked upon does not limit apparatus claims." However, the claims do not contain references to the materials or articles worked upon.

Claim 19 is allowable for the reasons stated above.

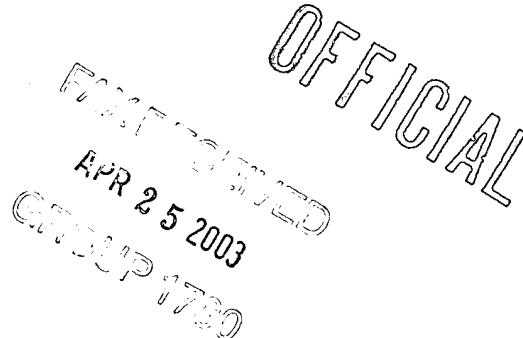
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Sincerely,



Deborah Blyveis
Birdwell, Janke & Durando, PLC
Reg. No. 47,337

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Page 6 - REQUEST FOR RECONSIDERATION (09/507,212)